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APPLICATION NO.	FILING DATE	FIRST NAMED IN	NVENTOR	A	TTORNEY DOCKET NO.
08/926,240	5 09/05/97	SULLIVAN	_	v	SLD-2035-1-1
<u>-</u>	QM11/0923 7 LD R BAHR DING &EVENFLO COMPANIES		$\neg$	EXAMINER GRAHAM, M	
DONALD R			. '		
	HARBOUR ISLA			ART UNIT	PAPER NUMBER
SUITE 200				3711	
TAMPA FL :	33602				
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Rlease find below and/or attached an Office communication concerning this application or an expense proceeding.

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## PARTMENT OF COMMERCE **Patent and Trademark Office**

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Washington, D.C. 20231

ſ	APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
	08/926,246	09/05/97	SULLIVAN	M	SLD-2035-1-2

QM11/0709

DONALD R BAHR SPALDING &EVENFLO COMPANIES 5730 NORTH HOOVER BOULEVARD TAMPA FL 33634

**EXAMINER** GRAHAM, M

PAPER NUMBER ART UNIT 3711

DATE MAILED: -87/09/98

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks** 

Application No. 08/926,246

Mark S. Graham

Applicant(s)

Sullivan

Office Action Summary Examiner

Group Art Unit 3711



Responsive to communication(s) filed on	·				
☐ This action is <b>FINAL</b> .					
☐ Since this application is in condition for allowance except for formal matters, prosecut in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.					
A shortened statutory period for response to this action is set to expire3 month is longer, from the mailing date of this communication. Failure to respond within the period application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained 37 CFR 1.136(a).	od for response will cause the				
Disposition of Claims					
	e pending in the application.				
Of the above, claim(s) is/are v	withdrawn from consideration.				
Claim(s)					
Claim(s)					
☐ Claims are subject to restrice					
Application Papers  X See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.					
☐ The drawing(s) filed on is/are objected to by the Examiner.					
	☐disapproved.				
☐ The specification is objected to by the Examiner.					
☐ The oath or declaration is objected to by the Examiner.					
Priority under 35 U.S.C. § 119					
☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)					
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been					
☐ received.					
received in Application No. (Series Code/Serial Number)					
$\square$ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).					
*Certified copies not received:					
☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119	(e).				
Attachment(s)					
Notice of References Cited, PTO-892     Notice of References Cited					
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s).					
<ul> <li>☐ Interview Summary, PTO-413</li> <li>✓ Notice of Draftsperson's Patent Drawing Review, PTO-948</li> </ul>					
☐ Notice of Informal Patent Application, PTO-152					
SEE OFFICE ACTION ON THE FOLLOWING PAGES	_				

Serial Number: 08/926,246

Art Unit: 3711

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Proudfit.

Proudfit discloses the claimed invention with the exception of the particular hardness/specific gravity claimed. However, Proudfit discloses a hard inner cover and softer outer cover formed from materials such as those disclosed by the applicant. Obviously the exact hardness of the layers would have been up to the ordinarily skilled artisan depending on distance and feel considerations. Absent a showing of unexpected results, the particular parameters of Proudfit's ball, which is formed from the same materials in the same fashion claimed by applicant, would have been obvious to one of ordinary skill in the art.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-6 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-8 of copending Application No. 08/920,070. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a golf ball with a hard inner and soft outer layer.

Claims 1-8 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-6 of copending Application No. 08/870,585. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a golf ball with a hard inner and soft outer layer.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending applications. See In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP Section 804.

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Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number (703) 308-1355.

MSG June 28, 1998

> Mark S. Graham Primary Examiner